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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/532,807	03/21/2000	Thomas J. Pennaz	1142-1020.2	7376

7590

07/30/2003

MOTOROLA, INC.  
INTELLECTUAL PROPERTY SECTION  
LAW DEPT.  
1303 E. ALGONQUIN ROAD  
SCHAUMBERG, IL 60196-1078

EXAMINER

NORRIS, JEREMY C

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/532,807

Applicant(s)

PENNAZ, THOMAS J.

Examiner

Jeremy C. Norris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,28-30 and 32-38 is/are rejected.
- 7) ☒ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 25 November 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

New corrected drawings are required in this application because the original drawings are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 3, 28-30, and 32-36 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,429,831 (hereafter Babb).

Babb discloses, referring to figure 2, a RFID tag comprising, a first substrate (18), an antenna element (24) disposed on the first substrate, a second substrate (14) a first (34) and second (35) contact pad disposed on the second substrate, and a circuit (36) coupled to the first and second contact pads, wherein the first and second contact pads

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are designed to make electrical contact with the antenna element (see col. 3, lines 15-20) [claim 28], wherein the pads are polygons [claim 2], wherein a conductive adhesive is applied to a portion of the pads (see col. 4, lines 40-50) [claim 3], wherein at least one of antenna element, first contact pad and second contact pad is printed (see col. 4, lines 64-68) [claim 29], wherein the circuit is electrically coupled to the first and second contact pads [claim 30], wherein the first contact pad is disposed on the second substrate diagonally from the second contact pad [claim 32], wherein the first and second contact pads are electrically isolated from each other [claim 33], wherein the first and second contact pads are physically separated from each other [claim 34], wherein at least one of the first and second contact pads is printed with a material selected from a group consisting of: carbon and a metalized material (see col. 3, lines 1-10) [claim 35], wherein the antenna element is divided into a first half and a second half, and wherein the first contact pad is designed to make electrical contact with the first half of the antenna, and the second contact pad is designed to make electrical contact with the second half of the antenna (see col. 3, lines 35-50) [claim 36].

Claims 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,141,055 (hereafter Berry).

Berry discloses, referring to figures 5-9, an assembly comprising: a first substrate (10) having disposed thereon a first contact pad and a second contact pad; and a second substrate (20) overlaying the first substrate, wherein the second substrate comprises an aperture (22), wherein the aperture exposes at least a portion of the first

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contact pad and at least a portion of the second contact pad, and wherein the aperture is patterned such that it facilitates a placement of a circuit (23) in order to couple to the first and second contact pads [claim 37], wherein the second substrate adheres to the first substrate via an adhesive (see col. 3, lines 5-10), and wherein the first substrate can be removed from the second substrate (see figure 8) [claim 38].

### ***Response to Arguments***

Applicant's arguments with respect to claims 2, 3, 28-30, and 32-38 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

Claim 31 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Claim 30 states the limitation" wherein the circuit is electrically coupled to the first and second contact pads via a pressure sensitive adhesive film." This limitation, in conjunction with the other claimed limitations was neither found to be disclosed in, nor suggested by the prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 4,000,054	Marcantonio,
US 6,268,796	Gnadinger et al.,
US 6,285,324	Korisch et al..

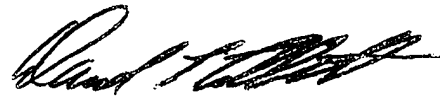
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy C. Norris whose telephone number is 703-306-5737. The examiner can normally be reached on Mon.-Th., 9AM - 6:30 PM and alt. Fri. 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on 703-305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0725 for regular communications and 703-308-0725 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

JCSN  
July 27, 2003



DAVID L. TALBOTT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800